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EXAMINER

BARQADLE, YASIN M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/745,846

Applicant(s)

RUSSEL, J. FRANCIS

Examiner

Yasin M Barqadle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03-08-2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 4, 6-24 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, and 25-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Response to Amendment**

1. Applicant's arguments filed on March 8, 2004 have been fully considered but they are not persuasive.

- Claims 4, 6-24 and 29 have been canceled.
- Claims 1-3, 5, and 25-28 are presented for examination.

In response to applicant arguments on page 6, paragraph 1 that ``there in no suggestion in Grapes, at all, ``prepare'' graphical content (associated with corresponding digital audio content) by implementing at least one format conversion''. Applicant's attention is directed to (Fig. 3c and col. 3, lines 29 to col. 4, line 13 and col. 10, lines 2-364), wherein Grapes teaches processing and presenting content package consisting of any combination of audio, video, text and stil or animated graphics to a user's terminal device. Grapes further teaches a computer program for processing multimedia content package.

As to applicant arguments on page 6, last paragraph that ``Grapes does not teach or suggest printing the graphics file and attaching the printed graphics to the computer readable medium.'' Applicant's attention is directed to (col. 3, lines 41-42; col. 12, lines 12-25 and col. 14, lines 23-31). Examiner could not find the word attaching or similar meaning in the specification. Nonetheless Grapes teaches a user requesting the presentation of a particular

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content package to be displayed to the proper reproduction devices located near the user (col. 3, lines 41-48; col. 12, lines 12-25). If printed output is appropriate, such output is printed on a printer connecting to user's computer and the system presents the user with a hard copy printed output (col. 14, lines 23-51). The printed physical output (associated with the content) may be predefined or may be dynamically generated according the user's request and may have a watermark or bar code for identification and verification purposes.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 25 recites the limitation "the computer readable medium" in line 7. There is insufficient antecedent basis for this limitation in the claim.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 1 02 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grapes US (6446130) in view of Kolling et al US (6385595).

As per claim 1, Grapes teach a method for preparing graphical content associated with corresponding digital audio content, comprising (abstract):

receiving said graphical content associated with said corresponding audio digital content from a digital database [col. 3, lines 29 to col. 4, line 13 and col. 10, lines 2-37]; and

preparing said graphical content for packaging with said corresponding digital audio content (col. 4, lines 2-13 and col. 10, lines 2-37).

Although Grapes shows substantial features of the claimed invention, including a computer program for processing and

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identifying multimedia content package, he does not explicitly show a software program for manipulating, converting and creating both postscript and PDF files.

Nonetheless, these applications are well known in the art and would have been an obvious modification of the system disclosed by Grapes, as evidenced by Kolling et al USPN. (6385595).

In analogous art, Kolling et al whose invention is about preparing electronic statement that includes audio, full motion video, graphics, images and custom enclosure, disclose template authoring system that utilizes of-the-shelf software program (packages) for manipulating, converting and creating both postscript and PDF files [Col. 9, lines 53 to col. 10, line 25]. Giving the teaching of Kolling et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Grapes by employing of-the-shelf software packages taught by Kolling et al for their ubiquitous use in desktop publishing and printable materials and for their support in creating, editing and converting file formats (i.e., converting Postscript to PDF [col. 10, line 1-25]. Knolling teaches printing said (PDF) files [col. 19, lines 40-57].

As per claim 2, Grapes teach the method according to claim 1, wherein said receiving step comprises downloading said

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graphical content from said digital database [col. 3, lines 9-13 and col. 5, lines 8-39].

Knolling as modified teaches a first software program with a format compatible to graphical content [col. 10, lines 11-25].

As per claim 3, Kolling et al teach the method according to claim 2, wherein the first software program includes Quark Xpress [col. 23, lines 10-25].

As per claim 5, Kolling et al teach the method according to claim 2, wherein the first software program includes Acrobat Distiller [col. 10, lines 11-16].

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual

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Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Grapes USPN (6446130).

As per claim 25, Grapes teach a method for transmitting media to a consumer over a public computer network comprising:

transmitting a digital media file over the computer network to a user's personal computer in response to user's request for the digital media file [col. 3, lines 29-67 and col.5, lines 22-51]; and

transmitting a graphics file associated with the digital media file to the user's personal computer over the computer network [col.4, lines 2-13 and col.5, lines 22-51; and

printing the graphics file and attaching the printed graphics to the computer readable medium [printed physical output (associated with the content) may be predefined or may be dynamically generated according the user's request



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and may have a watermark or bar code for identification and verification purposes col. 12, lines 12-25 and col. 14, lines 23-51. see also col. 8, lines 4-12].

As per claim 26, Grapes teach the method according to claim 25, further comprising receiving the digital media file and the graphics file at the user's personal computer [col.4, lines 2-13 and col.5, lines 22-51].

As per claim 27, Grapes teach the method according to claim 26, further comprising converting the graphics file to a printable format after receiving it [printable materials include promotional graphical content [col. 8, lines 4-12 and col. 19, lines 40-57].

As per claim 28, Grapes teach the method according to claim 26, further comprising storing the digital media file on a computer readable medium [col.3, lines 9-13].

### **Conclusion**

5. **ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date

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of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Bargadle whose telephone number is 703-305-5971. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 703-305-9717. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.  
Yasin Bargadle



FRANTZ B. JEAN  
PRIMARY EXAMINER